

REMARKS

Upon entry of this Amendment, claims 1-20 remain pending, with claims 1-10 withdrawn from consideration as drawn to a nonelected invention and claims 11-20 under current examination. In the Office Action,¹ the Examiner took the following actions;

- (a) rejected claims 11, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Shimagaki et al. (U.S. Patent No. 6,953,388) ("Shimagaki") in view of Burke (U.S. Patent App. Pub. No. 2002/0098789) ("Burke");
- (b) rejected claims 12-16 under 35 U.S.C. § 103(a) as being unpatentable over Shimagaki in view of Burke and further in view of You et al. (U.S. Patent No. 6,663,787) ("You"); and
- (c) rejected claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Shimagaki in view of Burke and further in view of Jang et al. (U.S. Patent No. 5,702,977) ("Jang").

Applicants traverse the rejections for the following reasons.

Procedural Issues (Request for Acknowledgement of IDS Materials):

Applicants note that in the two most recent Office Actions, mailed on April 4, 2006 and November 14, 2005, respectively, **the Examiner did not indicate that he considered the documents listed under the "Non Patent Literature Documents" on the PTO/SB/08 forms filed with Information Disclosure Statements on February 14, 2006, January 12, 2006, August 10, 2005, and May 5, 2005.**

Applicants respectfully request that the Examiner acknowledge consideration of the listed "non patent literature documents" by initialing the appropriate portions of the PTO/SB/08 forms originally filed (available on PAIR), and request a copy be returned to Applicants with the next communication from the Office.

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

Amendment to the Claims:

Applicants have amended claim 11 to more appropriately define the present invention. Support for the claim amendment may be found in the specification at, for example, page 26, lines 3-8.

Rejection of Claims 11, 19, and 20 under 35 U.S.C. § 103(a):

Applicants request reconsideration and withdrawal of the rejection of claims 11, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Shimagaki in view of Burke. Applicants respectfully disagree with the Examiner's arguments and conclusions. No *prima facie* case of obviousness has been established. As M.P.E.P. § 2142 states, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness."

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 4 (October 2005), p. 2100-134.

Each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143. A requirement for establishing a *prima facie* case of obviousness is not met, because neither Shimagaki nor Burke, nor their combination, teaches or suggests each and every element of Applicants' claims. Specifically, neither Shimagaki nor Burke, taken alone or in combination, teach or suggest at least Applicants' claimed "polishing pad having a compression elastic modulus ranging from 100 to 600 MPa," as recited in amended independent claim 11.

First, Shimagaki, taken alone, does not teach or suggest the claimed “polishing pad having a *compression* elastic modulus ranging from 100 to 600 MPa” (claim 11, emphasis added). When discussing polishing pad stiffness, Shimagaki discusses the “*flexural* modulus of elasticity” of the polishing pad. See Shimagaki, col. 12, lines 33-44. A flexural modulus of elasticity, however, is a different parameter from a compression elastic modulus. Even though Shimagaki discusses volume elastic modulus (See col. 17, lines 44-64), this still does not constitute the claimed “polishing pad having a compression elastic modulus ranging from 100 to 600 MPa” (claim 11). Shimagaki therefore does not teach or suggest each and every element of independent claim 11.

Second, Burke, taken alone, does not teach or suggest a “polishing pad having a *compression* elastic modulus ranging from 100 to 600 MPa” (claim 11, emphasis added). When discussing polishing pad stiffness, for example in paragraph [0077], Burke discusses the “*tensile* modulus” of the polishing pad. A tensile modulus, however, is a different parameter from a compression elastic modulus, and Burke therefore does not teach or suggest the claimed “polishing pad having a compression elastic modulus ranging from 100 to 600 MPa” (claim 11).

Accordingly, because neither Shimagaki nor Burke teaches or suggests at least the claimed “polishing pad having a compression elastic modulus ranging from 100 to 600 MPa” according to amended independent claim 11, the Examiner’s proposed combination of Shimagaki and Burke also fails to teach or suggest every feature of Applicants’ amended independent claim 11.

In addition, the Examiner has not established the requisite motivation necessary to combine Shimagaki and Burke from within the references themselves. The Federal Circuit has noted that “virtually all [inventions] are combinations of old elements.” See *e.g.*, *In re Rouffet*,

149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (internal citations omitted). The Federal Circuit has explained that an examiner may find every element of a claimed invention in the prior art, but mere identification is not sufficient to negate patentability. *See id.* The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.*

The desire to combine or modify the references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *See In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002), 61 USPQ2d 1430, 1433 (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52). Also, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be “clear and particular.” *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, the Examiner does not show that a skilled artisan, considering Shimagaki and Burke, and not having the benefit of Applicants’ disclosure, would have been motivated to combine the references in a manner resulting in Applicants’ claimed combination. The Examiner merely provided descriptions of how the references allegedly teach certain features without providing “clear and particular” reasons why a skilled artisan “would select the elements from the cited prior art references for combination in the manner claimed.” *See In re Dembicziak*, 175 F.3d at 999, 50 USPQ2d at 1617; *In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1457.

For at least these reasons, no *prima facie* case of obviousness of amended independent claim 11 has been established. Independent claim 11 is therefore allowable, for the reasons argued above, and dependent claims 19 and 20 are also allowable at least by virtue of their

respective dependence from allowable base claim 11. Therefore, Applicants request that the improper 35 U.S.C. § 103(a) rejection be withdrawn.

Rejection of Claims 12-16 under 35 U.S.C. § 103(a):

Applicants request reconsideration and withdrawal of the rejection of claims 12-16 under 35 U.S.C. § 103(a) as being unpatentable over Shimagaki in view of Burke and further in view of You. Applicants respectfully disagree with the Examiner's arguments and conclusions.

Applicants have already demonstrated in the previous section that Shimagaki and Burke, taken alone or in combination, fail to teach or suggest all the elements of amended independent claim 11. The Examiner's application of You fails to cure the deficiencies of Shimagaki and Burke in that it does not teach or suggest all elements recited in amended independent claim 11 and required by dependent claims 12-16. Therefore, the Examiner's application of You as an additional reference does not establish *prima facie* obviousness of Applicants' dependent claims 12-16. Dependent claims 12-16 are therefore allowable at least by virtue of their respective dependence from allowable base claim 11. The improper 35 U.S.C. § 103(a) rejection should be withdrawn.

Rejection of Claims 17 and 18 under 35 U.S.C. § 103(a):

Applicants request reconsideration and withdrawal of the rejection of claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Shimagaki in view of Burke and further in view of Jang. Applicants respectfully disagree with the Examiner's arguments and conclusions.

Applicants have already demonstrated herein that Shimagaki and Burke, taken alone or in combination, fail to teach or suggest all the elements of amended independent claim 11. The Examiner's application of Jang also fails to cure the deficiencies of Shimagaki and Burke in that it does not teach or suggest all elements recited in amended independent claim 11 and required

by dependent claims 17 and 18. Therefore, the Examiner's application of Jang as an additional reference does not establish *prima facie* obviousness of Applicants' dependent claims 17 and 18. Dependent claims 17 and 18 are allowable at least by virtue of their respective dependence from allowable base claim 11. The improper 35 U.S.C. § 103(a) rejection should be withdrawn.

Conclusion:

In view of the foregoing, pending claims 11-20 are in condition for allowance.

Applicants request a favorable action.

If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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